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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,202	12/13/2001	Thomas Blakeley	604.31-US1	4925
34284	7590	10/04/2006	EXAMINER	
ROBERT D. FISH RUTAN & TUCKER LLP 611 ANTON BLVD 14TH FLOOR COSTA MESA, CA 92626-1931			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/018,202

Applicant(s)

BLAKELEY ET AL.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/27/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-15 have been examined. Application 10/018,202 (CREATION OF CUSTOM MESSAGES USING VIRTUAL PROSPECTING) has a filing date 12/13/2001 and is a national stage entry of PCT/US00/08114 International Filing Date: 03/24/2000.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1 recites "creating a second commercial manually individualized at least in part on the response of the recipient", claim 2 recites "manually selecting the recipient from a list of prospective recipients" and claim 15 recites that the creating of a second commercial individualized at least in part on the response of the recipient to the commercial is executed automatically by an electronic agent. Applicant's specification does not clearly teach the definition of the term "manually" and Applicant's claims refers of manually creating a second commercial and at the same time automatically creating the same second commercial.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims recite "creating a second electronic commercial manually individualized". For purpose of art rejection, the term "manually individualized" would be interpreted as a person using a computer keyboard to select a recipient from a list. Claim 15 recites the limitation "to the commercial are executed automatically by an electronic agent". Said limitation is indefinite because it is not clear if the "the commercial" refers to the first or the second commercial.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (US 5,855,008).

Claim 1, Goldhaber teaches:

A method of advertising, comprising:

sending a first individualized electronic commercial to a recipient (see col 18, lines 49-61) ;

tracking a fast response-of the recipient to the first electronic commercial (see col 18, lines 49-61); creating a second electronic commercial individualized at least in part on the response of the recipient to the first commercial (see col 6, lines 1-7; col 18, lines

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49-61); sending the second electronic commercial to the recipient (see col 7, lines 45-67); and tracking a second response of the recipient to the second electronic commercial (see col 18, lines 49-61; col 7, lines 47-67; col 16, lines 10-25). Goldhaber does not clearly teach that said second commercial is “manually” individualized. However, Official Notice is taken that it is old and well known in the computer art to target advertisements to recipients by manually selecting said recipients from a list using a computer’s keyboard. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a salesman in Goldhaber would target ads to prospective buyers<sup>1</sup> by manually selecting said buyers from a list of prospective buyers using a computer’s keyboard as it is old and well known to do so and specially when Goldhaber already teaches that it is old and well known to “manually” create “news groups” or “chat groups” and then advertised said groups by email or word of mouth.

Claim 2, Goldhaber teaches:

The method of claim 1 wherein the step of sending the first electronic commercial to the recipient includes selecting the recipient from a list of prospective recipients (see col 5, lines 30-35). Goldhaber does not expressly teach “manually” selecting. However, the same argument made in claim 1 regarding this missing limitation is also made in claim 2.

Claim 3, Goldhaber teaches:

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<sup>1</sup> Goldhaber col 5, lines 20-25

The method of claim 1 wherein the step of sending the first electronic commercial to the recipient including selecting the first commercial from a list of available commercials (see col 5, lines 30-35).

Claim 4, Goldhaber teaches:

The method of claim 1 wherein the step of sending the first electronic commercial to the recipient includes assembling the first electronic commercial from a plurality of alternative components based at least in part upon a previously obtained marketing characteristic of the recipient (see col 5, lines 30-40).

Claim 5, Goldhaber teaches:

The method of claim 1 wherein the step of creating a second electronic commercial includes assembling the second electronic commercial from a plurality of alternative components based in part upon a previously obtained marketing characteristic of the recipient (see col 18, lines 50-61; col 16, lines 15-25).

Claim 6, Goldhaber teaches:

The method of claim 1 wherein the step of sending the first electronic commercial to the recipient includes assembling the first electronic commercial from a plurality of alternative components based at least in part upon a first previously obtained marketing characteristic of the recipient (see col 5, lines 30-35), and the step of creating a second electronic commercial includes assembling the second electronic commercial from the plurality of alternative components based in part upon a second previously obtained marketing characteristic of the recipient (see col 19, lines 55-65; col 7, lines 45-65).

Claim 7, Goldhaber teaches:

The method of claim 1 wherein both the first electronic commercial and the second electronic commercial are executable files (see col 7, lines 45-65).

Claim 8, Goldhaber teaches:

The method of claim 1 wherein the commercial includes an identification code (see col 7, lines 25-50).

Claim 9, Goldhaber teaches:

The method of claim 1 wherein the second commercial is communicated to the recipient as-an attachment to an e-mail (see col 20, lines 57-67).

Claim 10, Goldhaber teaches:

The method of claim 1 wherein the commercial includes a hyperlink to a web site (see col 16, lines 11-25).

Claim 11, Goldhaber teaches:

The method of claim 1 wherein the step of tracking includes determining whether the first electronic commercial is opened (see col 18, lines 49-62).

Claim 12, Goldhaber teaches:

The method of claim 1 wherein the step of tracking includes initiating a substantially synchronous link between the recipient and a person causing the first electronic commercial to be sent to the recipient (see col 20, line 59 – col 21, line 2).

Claim 13, Goldhaber teaches:

The method of claim 12 wherein the substantially synchronous link comprises a telephone call (see col 7, lines 60-65; col 13, lines 5-7).

Claim 14, Goldhaber teaches:

The method of claim 12 wherein the substantially synchronous link comprises a chat site (see col 20, line 59 – col 21, line 4).

Claim 15, Goldhaber teaches:

The method of claim 1 wherein at least one of the steps of sending a first electronic commercial to a recipient and creating a second electronic commercial individualized at least in part on the response of the recipient to the commercial are executed automatically by an electronic agent (see col 19, lines 39-67).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

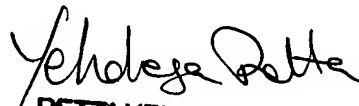
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra

September 23, 2006

  
RETTA YEHDEGA  
PRIMARY EXAMINER